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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 2657.2006-001
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>03-15-06</u> Signature <u>Donna Bartolone</u>	Application Number 09/873,785	Filed June 4, 2001
Typed or printed name <u>Donna Bartolone</u>	First Named Inventor Chaitanya Kanojia	Art Unit 2611
	Examiner Bui, Kieu Oanh T.	

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

attorney or agent of record.

Registration number 51,425

Michael J. Badzinski  
Signature

Michael J. Badzinski

Typed or printed name

978-341-0036

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

3/15/06

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

\*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Chaitanya Kanojia and Terri Swartz

Application No.: 09/873,785 Group: 2611

Filed: June 4, 2001 Examiner: Bui, Kieu Oanh T.

Confirmation No.: 2842

For: PROMOTIONS ON VIEWING DEVICES

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REMARKS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

These remarks are being filed with an accompanying Pre-appeal Brief Request for Review in response to the Office Action mailed from the U.S. Patent and Trademark Office on November 15, 2005 in the above-identified application. Please consider these remarks in the requested Pre-appeal Brief Review.

**REMARKS**

The following is being submitted with a Notice of Appeal under 37 C.F.R. § 41.31 and in support of a Pre-Appeal Brief Request for Review in the above-identified application.

In the subject application, a Final Office Action dated November 15, 2005 finally rejected claims 1-30, 33, 35-63 and 66 under 35 U.S.C. § 102 as being anticipated by U.S. Patent Number 6,177,931 to Alexander, *et al.*, hereinafter “Alexander” and claims 32, 34, 65 and 67 were rejected under 35 U.S.C. § 103 as being unpatentable over Alexander in view of U.S. Patent Number 6,795,973 to Estipona, hereinafter “Estipona”.

The Applicants believe these rejections of record are clearly not proper and without basis. In support of this position, the below presents clear legal and/or factual deficiencies in the rejections.

1. The Applicants respectfully submit that the Examiner has failed to show that Alexander either expressly or inherently discloses the Applicants' claimed ***transmission schedule wherein the transmission schedule contains control data that specifies a condition for activating the promotion for display in a display*** which is clearly recited in the above claims.

As argued in the Applicants' reply that was filed on August 18, 2005, Alexander fails to disclose this claimed aspect of the present invention.

In the Office Action, the Examiner seems to believe that Alexander discloses this aspect of the Applicants' claimed invention at column 32, lines 24-54 and column 32, line 61 to column 33, line 43. The Applicants respectfully disagree.

At column 32, lines 24-54, Alexander discloses a technique for customizing the presentation of advertising using viewer profile information. See Alexander, column 32, lines 22-23. The technique involves an electronic program guide (EPG), a profile program and the viewer profile information. See Alexander, column 32, lines 24-34. The viewer profile information contains data that is collected concerning and surrounding a viewer's interaction with a television. See Alexander, column 29, lines 14-20. The EPG and profile program use the viewer profile information to tailor the presentation and scheduling of advertisements to a viewer. See Alexander, column 32, lines 24-27.

Specifically, Alexander notes the viewer profile information may be used to customize an overlay message that is displayed on a particular advertisement. More particularly, Alexander notes that geographic information stored in the profile (e.g., a zip code) may be used to inform the EPG of a viewer's geographical location. The EPG may then select an overlay message based on the geographical information. The selected overlay message is displayed to the viewer when the advertisement is displayed. See Alexander, column 32, lines 39-54.

Alexander would not need a schedule that contains the Applicants' claimed control data because Alexander determines what advertisements to display based viewer profile information. The profile information is merely viewer profile data that is fed into the EPG or the profile program which has the built-in intelligence to examine the profile data and select what advertisements to display. Thus, including control information in the viewer profile data would not help Alexander because the decision as to what advertisement to display is made by the EPG and/or the profile program and not in the data that is fed to the EPG and/or profile program.

The Applicants, on the other hand, claim a schedule that contains control information that specifies conditions for displaying promotions. Here, intelligence (i.e., control information) that controls conditions for displaying the promotions is built into the schedule. Thus, a set top box that receives and processes the schedule need not be configured to determine conditions for displaying promotions. It merely needs to (1) examine the control information contained in the schedule to determine under what conditions a particular promotion should be displayed and (2) display the promotion when the conditions occur.

Thus, the technique described by Alexander to determine how an EPG is to be presented and/or what advertisements are to be displayed is not the same thing as a *transmission schedule that contains control data that specifies a condition for activating a promotion for display*.

At column 32, line 61 to column 33, line 43, Alexander discloses, *inter alia*, "access content" customization of advertisement messages displayed by the EPG. See Alexander, column 33, lines 26-28. Specifically, the EPG examines viewer profile information to identify a television program a viewer was watching just prior to entering the EPG. The EPG uses the identified television program to further identity an advertisement to display in the EPG. The selection of the advertisement is based on the content of the television program. See Alexander, column 33, lines 26-36. Once again, the data that is input to the EPG is merely profile data, as

described above. The EPG implements the intelligence to use this data to select an advertisement to display. Nowhere does Alexander suggest that this information contains ***control information that contains conditions for activating a promotion*** as claimed by the Applicants.

2. The Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to the Applicants' claimed ***transmission schedule wherein the transmission schedule contains control data that specifies a condition for activating the promotion for display in a display*** which is clearly recited in the above claims.

As noted above, the Examiner has failed to show that Alexander discloses the Applicants' claimed ***transmission schedule wherein the transmission schedule contains control data that specifies a condition for activating the promotion for display in a display***. In addition, the Examiner has failed to show that this claimed aspect of the present invention is present in Estipona.

**CONCLUSION**

According to the forgoing, it is respectfully requested that the panel find:

(i) that all existing claims are in condition for allowance and that the application should pass to issue,

or in the alternative,

(ii) that prosecution on the merits of the case should be reopened with an appropriate Office communication.

If a telephone conference would expedite prosecution of this case, the undersigned may be reached at (978) 341-0036.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

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Dated: 3/15/06